

REMARKS

Applicant has studied the Office Action of 22 May 2003 and offers the following remarks in response thereto. Initially, Applicant notes that claim 101 is amended to correct a typographical error in its dependency. Applicant acknowledges the withdrawal of the previous rejection and turns to the rejection presented in the current Office Action.

Claims 61-64, 66, 70, 71, 73, 76-79, 81, 85, 86, 88, 91-94, 96, 100-103, 106-111, 115, 116, and 118 were rejected under 35 U.S.C. § 103 as being unpatentable over Miska et al. in view of White et al. Applicant respectfully traverses. For the Patent Office to reject a claim over a combination of references, the prior art must show a motivation to combine the references. MPEP § 2143.01. To establish *prima facie* obviousness, the Patent Office must show where in the references each and every element of the claim is shown. MPEP § 2143.03. Further, the combination must not render the references unsuitable for their intended purpose or change their principle of operation. MPEP § 2143.01. If the Patent Office's only motivation to combine the references was created through the use of impermissible hindsight reconstruction, the rejection over the combination is improper. *Id.*

In the present case, the Patent Office has used Miska to show, allegedly, all of the claim elements except the packet network. Applicant specifically traverses the statement in the Office Action that Miska's element 104 teaches "receiving means for receiving at the calling party's communication device." Miska's element 104 is a toll switch, which is separated from the calling party's communications device by the local office 103. Under any reasonable interpretation of the claim language, especially in light of the exemplary defined communications devices of the specification (see page 4, lines 11-19), the toll switch 104 of Miska cannot be considered receiving means for receiving at the calling party's communication device.

Assuming, without admitting, that the Patent Office can identify another element in Miska which shows the receiving means, Applicant addresses two fundamental problems with the rejection. First, the Patent Office has not provided any evidence to support the motivation to combine the references. The Patent Office, on page three of the Office Action, indicates that

it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine White's communication system including Internet network with Miska's communication system with the motivation being to provide capability for the system to offer telephone service to end users over

the Internet via the public telephone network without the necessity of reliance on signaling systems of interexchange carriers.

There is no support in the Office Action for this motivation, and it appears that this motivation was constructed out of impermissible hindsight reconstruction.

Second, implementing White's Internet network communication system into Miska's communication system either does not show the claimed invention, or, if some non-obvious modification is performed on the combination, causes the communication system to operate under a different principle. In either case, based on the standards for patentability in an obviousness determination, the claims define over the rejection of record. Specifically, the normal combination of White's Internet network into Miska's communication system results in a spurious, extra step. In Miska's system, a calling party 101 places a call in the PSTN. This call hits the local office 103, is passed to the toll switch 104, goes over the trunks of the PSTN to another toll switch 128, and then passes into the paging network. The paging network uses the paging node 112 to page the called party's pager 114. The called party may then use mobile phone 102, which operates in the PLMN, to call a switching office 120 (also in the PLMN). The call is routed from the switching office 120 back onto the PSTN via local office 124 and through toll switches 126, 128, 104 back to the original calling party 101.

White describes a system that is designed to reduce long distance tolls by taking calls in the PSTN into the Internet, but importantly, reroutes the call back onto the PSTN for completion (see White's gateway routers 104, 116). If White were incorporated into this system, the Internet 106 of White would be inserted between toll switch 104 and toll switch 128, or perhaps between toll switch 126 and toll switch 104. In either case, the Internet portion of the call is encapsulated by the PSTN portions of the call. Likewise, in either case, the receiving means for receiving at the calling party's communication device a packet based message proving an indication of the treatment is not shown. This is because by the time the message reaches the calling party's communication device, the message is no longer in packet based form. Since the receiving means does not receive a packet based message, the combination does not show all the claim elements and the Patent Office has not established *prima facie* obviousness.

If the Patent Office maintains that the entire PSTN portions of Miska's system are replaced with just the Internet 106 of White, then this so changes the principle of operation of

Miska as to violate the strictures of MPEP § 2143.01. In either case, the Patent Office's rejection does not render the claims obvious.

Claims 61-64, 66, 70, 71, 73, 76-79, 81, 85, 86, 88, 91-94, 96, 100-103, 106-111, 115, 116, and 118 all recite the packet based language (either by amendment herein or from previous responses), and are patentable over the rejection of record for the reasons explained above.

Claims 65, 67-69, 72, 74, 75, 80, 82-84, 87, 89, 90, 95, 97-99, 102, 103, 105, 110, 113, 114, 117, 119, and 120 were rejected under 35 U.S.C. § 103 as being unpatentable over Miska et al. in view of White et al. and further in view of Creswell et al. Nothing in Creswell cures the problems of the underlying combination of Miska and White. Thus, the rejection is improper for the reasons set forth above.

Applicant requests reconsideration of the rejection in light of the amendments and remarks presented herein. Specifically, the combination of record has been created using impermissible hindsight reconstruction and does not result in the claimed invention. If the combination is somehow modified to result in the claimed invention, the modification changes the principle of operation of the references such that they may no longer be suitable for their intended purpose. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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